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**REMARKS**

Claims 1-11, 18-23, and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Carlsen in view of DiIorio. Claims 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Carlsen and DiIorio in view of Ostergaard. Claims 14-17 and 24-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Carlsen. Claims 27 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Carlsen in view of Ostergaard. Claims 29, 30, 33-35, 42-44, and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Carlsen in view of Thomas. Claims 31 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Carlsen and Thomas in view of Hastings. Claims 36-41, 48, and 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Carlsen and Thomas in view of DiIorio. Finally, claims 45 and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Carlsen and Thomas in view of Ostergaard. These rejections are respectfully traversed for the reasons discussed below.

**Framing System Claims – Independent Claims 1, 14, and 50 and their Dependents**

Claim 1 recites that the frame members are detachably connectable together such that they can be connected to each other to form the base structure as an open frame and can be subsequently disassembled by disconnecting the frame members from each other. Claim 1 also specifies that the clamping structure is formed from a plurality of individual clamping members that attach to the frame members.

As discussed in the response to the first Office Action, it would not have been obvious to combine DiIorio with Carlsen in the manner required to meet these claim limitations. Carlsen clearly shows a solid back piece 8 that spans the entire print 7 being displayed. That back piece 8 is shown as being a unitary (one-piece) component. This is clear by the cross-hatching of Fig. 2 and the enlarged cross-section of Fig. 3. The mitered feature noted by the Examiner in Fig. 1 may simply be a decorative addition to make the exposed portion of the back piece 8 appear to be unitary with the frame A (which is likely made by connecting together four frame pieces). This would explain why the mitered feature is not shown in the depressed portion 11 of Fig. 1 where the

frame A is cut-away. This would also render the figures of the Carlsen patent consistent with each other, which Applicant submits is a more appropriate interpretation than proceeding from the assumption that the figures are misleading.

Regardless, even if it is considered obvious that one could make the back piece 8 out of multiple parts glued or otherwise joined together, it would not have been obvious to the use frame pieces of DiIoia for this purpose since using the frame members of DiIoia in place of Carlsen's back piece 8 would require the following modifications:

1. the back piece 8 would have to be changed to an open frame;
2. a portion of the decorative front of the DiIoia frame members 10 would have to be flattened and provided with a depressed groove 11 to receive the Carlsen frame A;
3. this same front portion of the DiIoia frame members would have to be provided with recessed spring sockets 14; and
4. an inner portion of the front of the DiIoia frame member would have to be raised to fit within the rabbeted portion 5 of the Carlsen frame A.

There is nothing in either of these references or the other prior art of record that provides the necessary suggestion or incentive to make these modifications. To the contrary, changing the back piece 8 to an open frame creates potential difficulties, such as being able to maintain the print 7 against the glass. Although a backing board could be used for this purpose, Carlsen notes that his invention does not require "the customary work of securing the usual card board or wood backing in place" and that "the usual paper covering [over the back of the frame] is not required." Thus, making the modification suggested in the Office Action would eliminate the main objects of Carlsen's invention.

Not only does Carlsen teach away from using the DiIoia open frame for the back piece 8, but the teachings of DiIoia itself would discourage one of ordinary skill in the art from using his frame members for Carlsen's back piece 8 since, as discussed in Applicant's response to the first Office Action, the primary advantage of DiIoia's invention is that it permits construction of a rigid frame of any desired dimension and this advantage would be lost if it was used in conjunction with Carlsen's fixed sized clamping frame A.

Accordingly, Applicant respectfully submits that the combination of Carlsen and DiIoia contemplated by the Office Action is improper. In this regard, Applicant notes that no prima facie case of obviousness has been made out since there was no proper suggestion or incentive included in the Office Action for the combination being made. The only motivation alleged for combining these references is "to provide a secure means for attaching the frame members together." But, Carlsen uses a solid back piece 8, not an open frame as in DiIoia and, although open frames are well known as noted by the Examiner, Carlsen states that the "main object [of his invention] is to dispense with the backing and brads usually used for securing a photograph in a frame, and also to dispense with the paper covering which is usually pasted or otherwise adhesively secured to the back of the frame." This he accomplishes by using a solid back piece instead of an open frame. Thus, one of ordinary skill in the art would not be motivated to use DiIoia's frame members in place of Carlsen's back piece.

Because there has been no prima facie showing of obviousness and because it would not be proper to combine the Carlsen and DiIoia references in the manner suggested, the subject claim 1 is not obvious in view of these references. Applicant therefore respectfully submits that claim 1 patentably defines over Carlsen, DiIoia, and the other prior art of record. The rejections of each of the dependent claims 2-13 rely on this same combination and so the rejection of these claims should be withdrawn as well.

Claim 14 has been amended to recite frame members that interconnect to form the base structure as an open frame. Again, as discussed above, it would not have been obvious in view of the teachings of Carlsen to use an open frame, nor has any proper suggestion, incentive, or motivation been shown as to why one would substitute an open frame for the solid back piece 8. To the contrary, Carlsen teaches away from the use of an open frame, as discussed above.

Claim 14 has also been amended to recite that the separate clamping members are "individually attachable directly to said base structure," meaning that each clamping member can be directly connected to the base structure rather than being indirectly

connected via, for example, another clamping member. This direct connection can be made using a fastener such as the pegs and holes of the illustrated embodiment or such as an adhesive or screws or can be made using another means such as a friction fit. In Carlsen, the frame A snaps onto the back piece 8 using two fasteners 13, one on the top frame piece (shown in hidden lines in Fig. 1) and the other on the bottom frame piece (a portion 14 of which is shown in the cut-away view of Fig. 1). Clearly, the left and right side frame pieces are connected indirectly by virtue of being attached to the top and bottom frame pieces. Thus, Carlsen does not teach or suggest separate clamping members that are individually attachable directly to the base structure since at least some of the frame A pieces are only connected indirectly. Accordingly, claim 14 patentably defines over the prior art. Claims 15-28 each ultimately depend from claim 14 and should be allowed therewith.

Claim 50 is directed to a framing system that includes a plurality of elongated frame members each having a pair of ends, some of the ends being mortised and others of the ends having a tenon that fits within one or more of the mortises to thereby form a mortise and tenon joint, wherein the frame members can be connected together at the ends to form an open frame having one of the mortise and tenon joints at each end of each of the frame members. The mortises and the tenons each have a laterally extending through-hole, wherein the through-hole of each tenon aligns with the through-hole of an associated one of the mortises when the frame members are connected together by the joints to form the open frame. The framing system also includes a plurality of clamping members that can be attached to the frame members, wherein at least some of the clamping members include a peg, with the pegs extending into the aligned through holes at each of the joints to thereby prevent each of the tenons from detaching from its associated mortise. As discussed above, there has been no prima facie case of obviousness made and it would not be proper to combine Carlsen and Diloia in the manner suggested in the Office Action. Furthermore, the Office Action did not address many of the limitations of claim 50 recited above and Applicant submits that none of the prior art of record discloses or suggests the claimed combination of features. Accordingly, claim 50 should be allowed.

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**Kit Claims – Independent Claims 29 and 48 and their Dependents**

The rejections of claims 29-46 are a repeat of the rejections given in the first Office Action and claims 47-49 have now been rejected on the same bases. The Examiner's response to Applicant's prior arguments only address Applicant's discussion that Thomas is non-analogous art and do not respond to Applicant's arguments concerning the deficiencies of Carlsen and Thomas, nor to Applicant's argument that Hastings is also non-analogous art.

As to the Examiner's indication that Thomas is analogous prior art, the determination as to whether or not it is analogous art does not turn on whether or not Thomas "shows a display" or whether the elements of that display are removed from a canister and assembled. The proper test is specified in M.P.E.P. § 2145 IX as follows: "A prior art reference is analogous if the reference is in the field of applicant's endeavor or, if not, the reference is reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)." This is the exact test applied by Applicant in his response to the first Office Action and has not been properly rebutted. The same test was applied to Hastings and this has also not been rebutted in the most recent Office Action. Nor has Applicant's arguments concerning a possible combination of Carlsen and Thomas been addressed. Accordingly, Applicant maintains the positions discussed in his previous response and respectfully submits that, for those reasons, the subject matter of claims 29-46 patentably defines over Carlsen, Thomas, and the other prior art of record.

As to claims 47-49, claim 47 depends from claim 29 and should be allowed therewith. Independent claim 48 is directed to a kit for framing of posters and the like. It includes a canister that holds a plurality of elongated frame members each having first and second ends that mate with complementary ends of another of the frame members, wherein the frame members can be connected together at the ends to form an open frame. It further includes a sheet material sized to fit within the frame and including holes located at the periphery of the sheet material, along with a plurality of pegs sized to fit within the holes. The kit also includes a plurality of elongated clamping members, wherein the clamping members can be attached via the pegs to the open frame with the

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pegs extending through the holes to thereby clamp the sheet material to the frame. The pegs can be part of the frame members, the clamping members, or separate components. None of the prior art of record discloses or suggests this combination of features and the above discussion concerning Thomas and the possibly combination of Carlsen and Thomas applies to these claims as well. Accordingly, claim 48 and dependent claim 49 should be allowed.

Finally, with regard to claim rejections based in part on Ostergaard, as discussed in Applicant's response to the first Office Action, Ostergaard does not make up for the deficiencies of the other prior art being relied upon by the Examiner in those rejections, and there has not been any proper rebuttal of Applicant's application of the test for non-analogous art. Accordingly, those same arguments from Applicant's first response are still deemed proper and applicable.

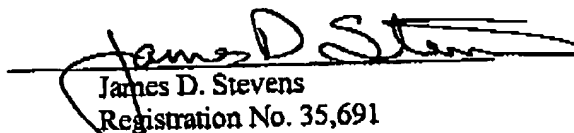
**Conclusion**

In view of the foregoing, Applicant respectfully submits that all claims are allowable over the prior art. Accordingly, reconsideration is requested. The Examiner is invited to telephone the undersigned if doing so would advance prosecution of this case.

The Commissioner is hereby authorized to charge the small entity fee for a two-month extension of time, as well as any deficiencies or fees or credit any overpayment associated with this communication to Deposit Account No. 50-0852.

Respectfully submitted,

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